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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,285

09/25/2006

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WAS0807PUSA

6497

22045 7590 02/12/2009

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EXAMINER

PAK, HANNAH J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/12/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,285	<b>Applicant(s)</b> BRIEHN ET AL.	
	<b>Examiner</b> Hannah Pak	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicants' amendment/remarks filed on 11/05/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-18 are rejected under 35 U.S.C. 103(a) as obvious over Olson et al. (US 4,491,508).

The rejection is adequately set forth in Pages 3-5 of Office action mailed on 08/14/2008 and is incorporated here by reference.

### ***Response to Arguments***

5. The arguments filed 11/05/2008 have been considered, but are not persuasive. Specifically, the applicants appear to argue that **A)** there is no certainty that any

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reaction with silica silanol groups takes place (see Page 3 of the Applicants' Remarks). They also argue that the applicant's reactive silyl compound does not correspond to the Olson's silyl acrylate (see Page 3 of the Applicants' Remarks). The applicants further **B)** rely on comparative example 2, and examples 3 and 5 from their specification to show that Olson does not form the claimed product (see page 4 of the Applicants' Remarks).

With respect to argument **A)**, Olson teaches hydrolyzing the silyl acrylate having the formula,  $(R^1O)_{4-a-b}(R)_aSi(CR^2)[CH(R^2)R^3O(C=O)C(R^2)=C(R^2)_2]_b$ , in the presence of aqueous colloidal silica having submicron-sized silica particles (Col. 1, lines 50-54, Col. 3, lines 45-50, and Col. 5, lines 53-61). Moreover, Olson's  $(R^1O)_{4-a-b}(R)_aSi$  correspond to the claimed  $(R^1O)_{3-n}(R^2)_nSi$ . Olson's  $(CR^2)[CH(R^2)R^3]$  when  $R^2$  is a hydrogen and  $R^3$  is a C1-C8, is structurally similar to the claimed  $CR^3_2$ , when  $R^3$  is equal to a hydrocarbon radical having 1-12 carbon atoms, see *MPEP* § 2144.09, *Chemical Compounds with Structural Similarity*. Olson's oxygen corresponds to the claimed A group. Olson's C=O (carbonyl group) corresponds to the claimed D group. Olson's  $C(R^2)=C(R^2)_2$  corresponds to the claimed C group. Therefore, Olson teaches or at least suggests the claimed composition.

With respect to argument **B)**, the examples the applicants rely on are not directed to hydrolyzing the silyl acrylate in the presence of aqueous colloidal silica and water-immiscible alcohol.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hannah Pak whose telephone number is (571) 270-5456. The examiner can normally be reached on Monday - alternating Fridays (7:30 am - 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HP/

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796